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Applicant/Appellant: Heinz Plank

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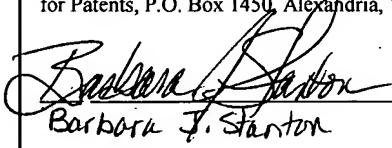
Examiner: Luan K. Bui

Attorney Docket: LVIP:111 US

Title: TRANSPORT CONTAINER FOR SLIDES FOR IMMUNOLOGICAL
LABELING FOR THIN TISSUE SECTIONS

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APPEAL BRIEF UNDER 37 CFR 41.37

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Sir:

This is an appeal from the Final Rejection dated November 9, 2006. Claims 1-14 stand finally rejected. Claim 14 has been canceled in an amendment filed concurrently with this brief under 37 CFR 41.33(b)(1). Claims 1-13 are the subject of this appeal.

A **Claims Appendix** begins at Page 29 of this brief.

An **Evidence Appendix** begins at Page 31 of this brief.

A **Related Proceedings Appendix** begins on Page 31 of this brief.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Leica Mikrosysteme GmbH (Leica) of Hernalser Hauptstrasse 219, Vienna, Austria A-1170. Leica is the assignee of the above-identified patent application as recorded on February 23, 2004 in the United States Patent and Trademark Office on Reel 015020, Frame 0287.

II. RELATED APPEALS AND INTERFERENCES

At this time, there are no other prior or pending appeals, interferences or judicial proceedings known to appellant or the appellant's legal representative which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-13 are pending in the application. Claims 1-14 are under Final Rejection as per the Primary Examiner's Final Office Action dated November 9, 2006. Claim 14 has been canceled in an amendment filed concurrently with this brief under 37 CFR 41.33(b)(1). Claims 1-13 are being appealed.

IV. STATUS OF AMENDMENTS

An 'AMENDMENT AFTER FINAL REJECTION AND REQUEST FOR RECONSIDERATION' was filed on January 9, 2007. However, the Primary Examiner did not enter this amendment.

An 'AMENDMENT UNDER 37 CFR 41.33(b)(1)' has been filed concurrently with this Appeal Brief cancelling Claim 14.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

Claim 1 recites: "A transport container for slides for immunological labeling of thin tissue sections comprising: a left and a right sidewall, a backwall and a frontwall joined together to form a peripheral delimiting wall having interior and exterior sides, a base attached to the peripheral delimiting wall closing off the transport container, at least one peripheral step formed in the interior side of the peripheral delimiting wall, and wherein said base comprises elevations operatively arranged for providing additional support to said slide."

The transport container for slides for immunological labeling of thin tissue sections refers generally to transport containers 40. See Figures 5-9 and paragraphs [0021] through [0026].

Left sidewall 53 is shown in Figures 5-7b and 9. See paragraph [0021], lines 15 and 17.

Right sidewall 54 is shown in Figures 7a-7b and 9. See paragraph [0021], lines 15 and 17.

Frontwall 51 and backwall 52, join together with left sidewall 53 and right sidewall 54 to form peripheral delimiting wall 49. Peripheral delimiting wall 49 is closed off by base 50. See Figure 7a and paragraph [0023], lines 11 and 17-20.

The embodiment shown in the figures includes three peripheral steps, first peripheral step 55, second peripheral step 56 and third peripheral step 57 along the inner surface of peripheral delimiting wall 49. See Figure 7a and Figures 8-9, and paragraph [0023], lines 20-24.

Base 50 includes elevations 58 and 59. See Figure 7a and Figure 8, and paragraph [0023], line 25. It should be appreciated, however, that the elevations are not specifically labeled in Figure 8, and are shown only in cross-section along with the elements described *supra*.

Together, these elements make available a transport container for slides for immune labeling of thin tissue sections that is suitable for an automatic treatment process and ensure reliable, error-free handling of the thin tissue sections on the slide.

Claims 2-11 depend from Claim 1. Claim 2 relates to the at least one peripheral step described above. Claim 2 affirmatively claims that the at least one peripheral step is continuous along the peripheral delimiting wall.

Claim 3 further limits Claim 1 to include stops **70**. See Figures 5-7b paragraph [0024] lines 16-18, and paragraph [0026] line 27.

Claim 4 further limits Claim 1 such that transport containers **40** are preferably arranged in stack **20**, whereby base **50** of one transport container serves as a cover for a transport container beneath it. See Figures 5 and 7b, and paragraph [0021], lines 9-11.

Claim 5 further limits Claim 1, reciting elevations **58** and **59** each having planar flattened area **60** located at the same level as the slide **4**. See Figures 5, 7a and 8, and paragraph [0024].

Claim 6 further limits Claim 5, specifying that elevations **58** and **59** have unique shapes, specifically a circle and an elongated hole, respectively. See Figures 7a and 8, and paragraph [0024]. Additionally, elevations **58** and **59** are cup shaped. See Figures 7b and 8, references **60**.

Claim 7 further limits Claim 1, claiming two grip recesses **62** arranged opposite one another in the region of the front wall. See Figures 5-7b, and paragraph [0023], line 3.

Claim 8 further limits Claim 1 and recites two parallel lugs **63** formed at back wall **52** that serve partially as guides for arranging transport containers **40** in stack **20**. See Figures 5, 7a-b, and paragraph [0023], lines 4-6.

Claim 9 further limits Claim 1 such that left and right sidewalls **53** and **54** each have at least one protrusion **61** operatively arranged such that slide **4** does not contact left or right sidewall **53** or **54** in the region of protrusion **61**. See Figure 6, 7a and 8, and paragraph [0023], lines 29-32, and lines 1-2 of the next page.

Claims 10 and 11 relate to the fabrication of transport container **40**. Claim 10 further limits Claim 1 such that transport container **40** is fabricated from a dimensionally stable material. Claim 11 further limits Claim 10 such that transport container **40** is injection molded. See paragraph [0023], lines 10-17.

B. Independent Claim 12

Claim 12 recites: "A transport container for slides for immunological labeling of thin tissue sections, comprising: a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base is attached to the peripheral delimiting wall, wherein the base closes off the transport container, at least one peripheral step formed in the interior of the transport container, wherein the slide rests and is

spaced away from the base of the transport container, and a grip recess is formed in the left and the right sidewall close to the front wall.”

Claim 12 recites several equivalent structures as recited in Claim 1, including:

Transport containers **40** for slides for immunological labeling of thin tissue sections. See Figures 5-9 and paragraphs [0021] through [0026].

Left sidewall **53**. See Figures 5-7b and 9, and paragraph [0021], lines 15 and 17.

Right sidewall **54**. See Figures 7a-7b and 9, and paragraph [0021], lines 15 and 17.

Frontwall **51** and backwall **52**, join together with left sidewall **53** and right sidewall **54** to form peripheral delimiting wall **49**. Peripheral delimiting wall **49** is closed off by base **50**. See Figure 7a and paragraph [0023], lines 11 and 17-20.

The embodiment shown in the figures includes three peripheral steps, first peripheral step **55**, second peripheral step **56** and third peripheral step **57** along the inner surface of peripheral delimiting wall **49**. See Figure 7a and Figures 8-9, and paragraph [0023], lines 20-24.

Claim 12 further recites that slide **4** rests on the at least one peripheral step, *i.e.*, step **57**, and is spaced away from the base of the transport container. See Figures 8 and 9, and paragraphs [0023] through [0026].

The transport container recited in Claim 12 further includes two grip recesses **62** arranged opposite one another in the region of the front wall. See Figures 5-7b, and paragraph [0023], line 3.

C. Independent Claim 13

Claim 13 recites: “A transport container for slides for immunological labeling of thin tissue sections comprising: a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base attached to the peripheral delimiting wall, wherein the base closes off the transport container, at least one peripheral step formed in the interior of the transport container, wherein the slide rests and is spaced away from the base of the transport container, and two parallel lugs formed at the back wall which serve as guide for arranging the transport container in a stack.”

Claim 13 recites several equivalent structures as recited in Claim 1, including:

Transport containers **40** for slides for immunological labeling of thin tissue sections. See Figures 5-9 and paragraphs [0021] through [0026].

Left sidewall **53**. See Figures 5-7b and 9, and paragraph [0021], lines 15 and 17.

Right sidewall **54**. See Figures 7a-7b and 9, and paragraph [0021], lines 15 and 17.

Frontwall **51** and backwall **52**, join together with left sidewall **53** and right sidewall **54** to form peripheral delimiting wall **49**. Peripheral delimiting wall **49** is closed off by base **50**. See Figure 7a and paragraph [0023], lines 11 and 17-20.

The embodiment shown in the figures includes three peripheral steps, first peripheral step **55**, second peripheral step **56** and third peripheral step **57** along the inner surface of peripheral delimiting wall **49**. See Figure 7a and Figures 8-9, and paragraph [0023], lines 20-24.

Claim 13 further recites that slide **4** rests on the at least one peripheral step, *i.e.*, step **57**, and is spaced away from the base of the transport container. See Figures 8 and 9, and paragraphs [0023] through [0026].

The transport container recited in Claim 13 further includes two parallel lugs **63** formed at back wall **52**, which serve as a guide for arranging transport containers **40** in stack **20**. See Figures 5, 7a-b, paragraph [0023], lines 4-6, and paragraph [0024].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether Claims 1-6 and 9-11 rejected in the Final Office Action dated November 9, 2006, are non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*).

B. Whether Claim 7 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*), further in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

C. Whether Claim 8 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*), further in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

D. Whether Claim 12 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

E. Whether Claim 13 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

VII. ARGUMENT

A. Ground of Rejection to be Reviewed on Appeal, *supra* Part VI(A)

Whether Claims 1-6 and 9-11 rejected in the Final Office Action dated November 9, 2006, are non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*).

i. Summary of the Rejection

The Primary Examiner in the Final Office Action dated November 9, 2006, finally rejected Claims 1-6 and 9-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296, 122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076, 681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*).

As recited by the Primary Examiner in the Final Office Action:

Claims 1-6 and 9-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (6,179,127; hereinafter Kato'127) or Nakazono et al. (6,296,122; hereinafter Nakazono'122) in view of Chenoweth (6,076,681) and Bloom (6,293,404). Kato'127 discloses a carrier/container (1) comprising a peripheral delimiting wall (22) which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base (Figures 11-12 and 16) is attached to the peripheral delimiting wall, at least one peripheral step (31b, 62) formed in the interior side of the peripheral delimiting wall of the carrier/container for holding an article (51). Kato'127 further discloses at least one protrusion (63, 64) formed in the left or the right sidewall. Nakazono'122 discloses a tray/container (1) comprising a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base (6) is attached to the peripheral delimiting wall, at least one peripheral step (3, Figures 1 and 2) formed in the interior of the tray/container for holding an article (2) spaced away from the base. The tray of Nakazono'122 formed from a thermoplastic material which is considered equivalent to a dimensionally stable material as claimed. Either Kato'127 or Nakazono'122 also discloses the other claimed limitations except for the base comprises elevations being operatively arranged for providing additional support for the article.

Chenoweth shows a carrier (10) comprising at least one corner support (18, 19, 21, 22) for supporting an article (24, 25) and at least one elevation (42, 43) for supporting a bottom surface of the article to providing an additional support for the article. Bloom suggest a carrier (100) having a first and a second elevation (134, Figure 10) with cup-shaped for supporting a bottom surface of an article.

It would have been obvious to one having ordinary skill in the art in view of Chenoweth and Bloom to modify the container of Kato'127 or Nakazono'122 so

the base includes elevations comprise a first and second elevation of cup-shaped for supporting the article for further supporting the article within the container. As to claim 2, Kato'127 discloses the at least one peripheral step is continuous (Figures 11-12).

As to claim 3, Nakazono'122 discloses at least one stop (11a).

As to claim 11, the container of Nakazono'122 formed by molding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the container of Nakazono'122 by injection because the selection of the specific method for forming the container would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well.

Appellant respectfully traverses this rejection.

ii. References Cited in support of the Rejection

U.S. Patent No. 6,179,127 (Kato et al.)

Kato et al. describe carrier tape 1 capable of being formed by means of a die apparatus. Carrier tape 1 has a plurality of recesses 2 for receiving semiconductor packages therein in a manner to be spaced from each other at predetermined intervals in a longitudinal direction. See Figure 1. Receiving recesses 2 have shelf sections 21 to support a periphery of a bottom surface of the semiconductor package thereon. See Figures 1, 5, 7, 10, 11 and 20. The periphery of the semiconductor package is not specifically labeled but illustrated as a dashed line in the embodiments shown in Figures 1, 10, 11, and 20. Receiving recesses 2 are also provided with sections 22 for positioning the semiconductor package. See Figures 1, 5, 7, 10, 11 and 20. Positioning sections 22 are respectively arranged between and adjacent two of shelf sections 21. Like most carrier tapes, *Kato et al.* is made from a flexible material that can be rolled up into a reel for bulk packaging, processing and shipment.

Kato et al. further describe shelf sections 21 being raised above the bottom surface of receiving recess 2 to a height greater than electrodes Sa of electronic component S to support thereon an outer periphery portion of the bottom surface of electronic component S. See Col. 2, lines 38-41; see also Figures 2 and 21. *Kato et al.* require adequate spacing between the base of recess 2 and bottom surface of electronic component S so as to protect and avoid damage to electrodes Sa of electronic component S. See Figures 2 and 21.

U.S. Patent No. 6,296,122 (Nakazono et al.)

Nakazono et al. describe stackable packaging trays **1**. See Figure 1. Packaging trays **1** are arranged to hold display elements, specifically LC (Liquid Crystal) panels **2**. Packaging tray **1** also includes position determining portion **11** provided near each side of packaging tray **1** for fixedly determining a stacking position of each packaging tray **1** with respect to at least one other packaging tray **1** placed above and beneath. See Figure 1. Position determining portion **11** is made into a concave shape which protrudes downward from a back surface of packaging tray **1** and has bottom portion **11a** and opening portion **11b**. Bottom portion **11a** of position determining portion **11** is made slightly smaller than opening portion **11b**. See Figures 1 and 4-5.

“[T]he bottom surface of the peripheral component holding concave portion **6** is leveled to prevent the warpage of the packaging tray **1**.” See Figure 1, Col. 5, lines 16-19. Additionally, LC display panel **2** is only supported at the outside peripheral edge of LC panel **2**, specifically outside effective display area **A**. See Col. 7, lines 16-21. By restricting the area where LC display **2** is supported, *Nakazono et al.* are able to fulfill their primary objective of reducing the risk of damaging the fragile LC panels, *i.e.*, scratching effective display area **A**. Also, “peripheral component holding concave portion **6** for holding peripheral components of the LC panel **2** is provided inside the LC panel holding concave portion **3**.” Col. 5, lines 12-15.

U.S. Patent No. 6,076,681 (Chenoweth)

Chenoweth describes microchip carrier tape **10**, which is similar to the tape disclosed by *Kato et al.* Carrier tape **10** has a plurality of pockets **11** longitudinally spaced with transverse bridges **27** for accommodating microchips **24**. See Figure 3. Tape **10** has a bottom wall having upright corner supports **18, 19, 21** and **22** and platforms **42, 43, 44** and **45** that engage and retain microchip **24** with pocket **11** and space leads **26** connected to microchip **24** from side walls **12** and **13**, end walls **16** and **17** and bottom wall **14** of tape **10**. See Figure 3-5. Cover tape **33** is releasably attached to side flanges **28** and **29** and bridges **27** of carrier tape **10** to close the top of pockets **11** and retain the positions of microchips **24** in pockets **11**. See Figure 3. Hole **15** in bottom wall **14** of tape **10** allows optical readings to verify the position of the microchip **24**. See Figure 5. Tape **10** is made from a thin, pliable and flexible “plastic strip of PVC or polystyrene plastic”. See Col. 3, lines 5-6.

U.S. Patent No. 6,293,404 (Bloom)

Bloom describes non-nesting microchip component carrier tape **10** having a plurality of sets of pockets **11, 12, 13, 14** and **15** for accommodating microchips. See Figure 1. Pocket **11** has side walls **27** and **28** and end walls **24** and **26** joined to generally flat bottom wall **29**. See Col. 4, line 2, Figures 1 and 3. Side wall **28** has recess **33** at the juncture of side wall **28** with end wall **24**. Recess **33** extends into bottom wall **29** and inhibits nesting of pockets **11, 12, 13, 14** and **15** that are superimposed when wound on a reel. *Bloom* further describes carrier tape **100** having pocket **111** which has cylindrical buttons or nubs **134** extending upwardly from bottom wall **129**. See Figures 8 and 10. Bottom walls **29** and **129**, further include holes **31** and **131**. See Figures 3 and 10. *Bloom* describes carrier tapes **10** and **100** as being intended to be wound on a reel. As is the case with the previously discussed carrier tapes, the microchip carrier tape in *Bloom* is an “elongated flexible plastic strip” so as to allow the tape to be wound up in a reel. Col. 2, lines 16-17.

iii. Arguments Traversing the Rejection of Claims 1-6 and 9-11

Claim 1 is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made and patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*).

The Final Office Action conceded that *Nakazono et al.* and *Kato et al.* fail to disclose a base comprising elevations operatively arranged for providing additional support for the (packaged) article according to Appellant’s claims. See page 3 of Final Office Action, lines 2-4. Notwithstanding the omissions of the primary references, the Final Office Action asserts that it would still be obvious under 35 U.S.C. 103(a) to modify the packaging tray of *Nakazono et al.* or *Kato et al.* in view of the teachings of *Chenoweth* or *Bloom*. The Final Office Action asserts that both *Chenoweth* and *Bloom* teach a base having at least one elevation. Appellant courteously disagrees with the combination of the *Chenoweth* and *Bloom* with either *Nakazono et al.* or *Kato et al.* As is discussed below, combining *Chenoweth* or *Bloom* would in effect destroy the utility of the inventions described in *Nakazono et al.* and *Kato et al.* References cannot properly be combined if in effect the combination would destroy the invention on which one of the reference patents is based. *Ex Parte Hartmann*, 186 U.S.P.Q. (BNA) 366 (1974).

Although not very well illustrated by the drawings of *Nakazono et al.*, Col. 7, lines 60-65 of *Nakazono et al.* recites:

In the above arrangement, when the LC panel 2 is placed in the packaging tray to be transported, as shown in Fig. 2, the peripheral components of the LC panel 2 are placed in the peripheral component holding concave portion 6 first, and thence the LC panel 2 is placed in the LC panel holding concave portion 3.
(Emphasis added)

Nakazono et al. further recite at Col. 5, lines 12-15:

A peripheral component holding concave portion 6 for holding peripheral components of the LC panel 2 is provided inside the LC panel holding concave portion 3.

Thus, *Nakazono et al.* make it quite clear by expressly teaching that inside the LC panel holding concave portion 3 there is a further component holding concave portion 6 below for holding peripheral components inside the LC panel holding portion. Hence, the introduction of elevations as suggested by *Chenoweth* or *Bloom* would prevent *Nakazono et al.* from packaging LC panels in concave portion 3 or components in concave portion 6. Additionally, *Nakazono et al.* recite that “the bottom surface of the peripheral component holding concave portion 6 is leveled to prevent the warpage of the packaging tray 1.” Col. 5, lines 16-19. Adding elevations to concave portion 6 would contradict the express teaching of *Nakazono et al.* to have concave portion 6 leveled.

Furthermore, the LC display is only supported at the outside portion of the LC panel 2, specifically outside of the effective display area A. See Col. 7, lines 16-21. By restricting the area where the LC display is supported, *Nakazono et al.* are able to fulfill their primary objective of reducing the risk of damaging the fragile LC panels. Accordingly, *Nakazono et al.* teach away from the combination elevations in their device in that *Nakazono et al.* restrict LC panel support to the outer peripheral portion of the LC panel so as not to damage or scratch the viewable area of the panel.

Once again, the Office Action acknowledges at the top portion of page 3 that *Kato et al.*, like *Nakazono et al.*, do not teach base elevations operatively arranged for providing additional support for their articles (slides) in accordance with Appellant’s Claim 1, etc.

Kato et al. describe, “a carrier tape which is capable of stably receiving semiconductor packages therein while keeping electrodes thereof from being brought into contact therewith.” Col. 2, lines 20-23. Additionally, *Kato et al.* describe shelf sections raised above the bottom surface of the receiving recess to a height greater than the electrodes of the electronic component to support thereon an outer periphery portion of the bottom surface of the electronic component. Col. 2, lines 38-41.

Thus, not only does *Kato et al.* fail to teach or suggest a base comprising elevations, but *Kato et al.* effectively teach away from incorporating such elevations. *Kato et al.* require adequate spacing between the base and bottom surface of the electronic component so as to protect and avoid damage to the electrodes of the packaged electronic component. See Figure 2, electrode **Sa**. *Kato et al.* are striving to protect electrodes **Sa** from making contact with the bottom surface structures in their receiving recesses. See Fig. 2, and col. 7, lines 46-50. The device disclosed in *Kato et al.* would not function properly with elevations operatively arranged for providing additional support to a device. Thus, incorporating such a feature into the device described in *Kato et al.* would destroy the device’s utility since the elevations would interfere with electrodes **Sa**.

Assuming *arguendo* that *Chenoweth* and *Bloom* teach base elevations, their incorporation thereof into the device described by *Kato et al.* would be avoided because of the likelihood that such elevations would damage the semi-conductor electrodes. Hence, as in the case of *Nakazono et al.*, *Kato et al.* clearly make the use of elevations inappropriate. The safety of the devices meant to be contained in both *Nakazono et al.* and *Kato et al.* would be jeopardized if elevations were introduced. The likelihood of damage occurring to the devices would greatly increase. According to *Ex Parte Hartmann*, the references cannot be combined because the teachings would impede or destroy the utility of the carrier tape described by *Kato et al.* and *Nakazono et al.*

For the reasons outlined above, Claim 1 is patentable over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth* and *Bloom*. Claims 2-6 and 9-11, being directly or indirectly dependent from Claim 1 include all the structural features of Claim 1, plus any additional limitations from intervening claims. Consequently, dependent Claims 2-6 and 9-11, are also patentable over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth*

and *Bloom*. Thus, Claims 1-6 and 9-11 are patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejection.

iv. Claim 4 is Separately Patentable; Arguments Traversing the Rejection of Claim 4

Even if Claim 1 is found to be obvious over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth* and *Bloom*, Claim 4 is separately patentable and argued herein. The Final Office Action relies upon *Nakazono et al.* in regards to the stackable component of Claim 4. In addition to all of the reasons previously recited, *Nakazono et al.* fail to render Claim 4 obvious under 35 U.S.C. 103(a).

As previously recited, *Nakazono et al.* fail to teach or suggest elevations. Assuming *arguendo* that either *Chenoweth* or *Bloom* teaches elevations and it is appropriate to combine teachings from *Chenoweth* or *Bloom* to that of *Nakazono et al.* for the purposes of rendering the elevations obvious, their combination would be inappropriate and ineffective in rendering obvious the stackable component. Both *Chenoweth* and *Bloom* teach against stacking. *Chenoweth* and *Bloom* rely upon the rolling of the carrier tapes into a reel. *Chenoweth* teaches cover tape 33 (see Figure 3) to prevent stacking and *Bloom* discusses structural features to deter stacking in the abstract, reciting in part: “[t]he bottom walls of the pockets have extension that inhibit nesting or copulation of portions of the tape that are superimposed when wound on a reel.” (Emphasis added).

For all of the reasons recited above, including those reasons recited for Claims 1-6 and 9-11 as a whole, Claim 4 is separately patentable over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth* and *Bloom*. Claim 4 is patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejection.

B. Ground of Rejection to be Reviewed on Appeal, *supra* Part VI(B)

Whether Claim 7 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (Kato et al.) or U.S. Patent No. 6,296,122 (Nakazono et al.) in view of U.S. Patent No. 6,076,681 (Chenoweth) and U.S. Patent No. 6,293,404 (Bloom), further in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (Anthony et al.).

i. Summary of the Rejection

The Primary Examiner in the Final Office Action dated November 9, 2006, finally rejected Claim 7 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296, 122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076, 681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*) in further view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

As recited by the Final Office Action in the Final Office Action:

Claim 7 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of The Official Notice and Anthony et al. (2002/0029989; hereinafter Anthony'989). The container of Kato'127 or Nakazono'122 as modified further fails to show two grip recesses in the region of the front wall. The Official Notice is taken of the old and conventional practice of providing a container having two grip recesses to facilitate carrying the container. Anthony'989, is cited by way of example only, shows a container (10) comprising two grip recesses (28) arranged opposite one another (Figure 1). It would have been obvious to one having ordinary skill in the art in view of The Official Notice and Anthony'989 to modify the container of Kato'127 or Nakazono'122 so in the region of the front wall comprises two grip recesses to facilitate carrying and/or holding the container.

Appellant respectfully traverses this rejection.

ii. References Cited in support of the Rejection

Appellant hereby reasserts the descriptions of the references previously presented. The new reference cited in the Final Office Action in rejecting Claim 7 is U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*)

Anthony et al. describe an apparatus **10** for the safe handling of sharp implements. Apparatus **10** includes plastic rectangular handling receptacle **12**. Magnets **46** are embedded within to secure a sharp implement such as a needle. See Figure 1. Apparatus **10** further includes longitudinal side walls **16** preferably having indentation **28** at approximately the mid-point along the length to accommodate holding the apparatus between a thumb and a finger of a user. See Figure 1, and paragraph [0025].

iii. Arguments Traversing the Rejection of Claim 7

Claim 7 is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made and patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296, 122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076, 681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*) in further view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

Paragraph 4 of the Final Office Action expressly states *Kato et al.* and *Nakazono et al.* fail to show two grip recesses in the region of the front wall. The Final Office Action takes Official Notice that the two grip recesses in the region of the front wall are from “the old and conventional practice of providing a container having two grip recesses to facilitate carrying the container.” Appellant respectfully disagrees.

Appellant asserts that Claim 7, dependent upon Claim 1, is patentable for all of the reasons recited *supra* regarding the patentability of Claim 1. See *supra* Part VII(A)(iii). In addition to these reasons, in assessing patentability, it is axiomatic, the Primary Examiner is required to consider all portions of a reference including those which teach away from Appellant’s claimed invention, and supports a conclusion of non-obvious, patentable subject matter. In this regard, *Nakazono et al.*, a primary reference relied on in rejecting Claim 7, clearly suggest that packaging trays, when employing grip recesses, should be located in the middle of

the tray. See *Nakazono et al.*, Figure 9, grip notches **29**. Any conclusion to the contrary, *i.e.*, placement of the grip recesses in the region of the front wall according to Appellant's Claim 7 would constitute hindsight reconstruction, prohibited under Section 103, and also under numerous Court holdings. See *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). Furthermore, grip notches **29**, as taught by *Nakazono et al.*, would be inoperative in Appellant's transport container as demonstrated by Appellant's Figure 6. Appellant's container **35** in Figure 6 shows the requirement that grip recesses **37** be positioned in the region of the front wall of container **35**. Container **35** is almost entirely enclosed by treatment section **16**, with only the front portion of container **35** being exposed. See Appellant's Figure 6. Grip notches **29** of *Nakazono et al.* are shown and described as positioned equidistant from the front and back wall. See *Nakazono et al.*, Figure 9.

Furthermore, the Primary Examiner's Official Notice alleged as a substitute for published prior art is without merit. Appellant's last response contested the conclusion of Official Notice because this structural feature is not believed to be so well known that prior art need not be cited in support thereof. In response thereof the Final Office Action cites *Anthony et al.* as supplemental published prior art.

However, *Anthony et al.* do not meet the criteria of Claim 7 because *Anthony et al.* fail to teach or suggest a transport container with two grip recesses in the region of the front wall arranged opposite one another. *Anthony et al.* expressly teach recesses **28** in the central portion of their tray for gripping purposes. See Figure 1, and paragraph [0025]. In contrast, Appellant's Claim 7 expressly requires his to be oppositely positioned grip recesses to be located in the region of front wall **51** because the mid-portion of sidewalls **53** and **54** of Appellant's transport container can be substantially covered by treatment portion **16**. See Appellant's Figure 6. Additionally, sidewalls **53** and **54** require central openings to accommodate tray clamps **28a**. See Appellants Figure 5. Consequently, the location of the recesses suggested by *Anthony et al.* in the mid-region of their storage tray will not be suitable for use according to Appellant's claimed invention.

Appellant also wishes to highlight for the record that the rejection of Claim 7 is based upon a collection of not fewer than **five references**. Such a large collection of art is probative

evidence of non-obviousness. While disclosing some of the structural elements of Appellant's claimed container, the need for the Primary Examiner to cite such a thicket of references, and still fail to present a *prima facie* case of obviousness is evidence of the presence of patentable subject matter. The examination process is intended to identify non-patentable subject matter as well as identify allowable claims reciting patentable subject matter. The Primary Examiner has failed to identify the plethora of patentable subject matter in Appellant's claims.

For all of the reasons recited above, including those reasons recited for Claims 1-6 and 9-11 as a whole, Claim 7 is patentable over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth* and *Bloom* in further view of *Anthony et al.* Claim 7 is patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejection.

C. Ground of Rejection to be Reviewed on Appeal, *supra* Part VI(C)

Whether Claim 8 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*), further in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

i. Summary of the Rejection

The Primary Examiner in the Final Office Action dated November 9, 2006, finally rejected Claim 8 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*), further in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

As recited by the Primary Examiner in the Final Office Action:

Claim 8 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view *Lafond et al.* (6,446,807; hereinafter *Lafond'807*) or *Burton et al.* (5,310,076; hereinafter *Burton'076*). The container of *Kato'127* or *Nakazono'122* as modified further fails to show the back wall comprises two parallel lugs that serve partially as guides for arranging the container in the stack. *Lafond'807* shows a container (12) having two parallel lugs (38, 44) that serve partially as guides for stacking the container. *Burton'076* suggests a container (100) having two parallel lugs (103, 107) that serve partially as guides for stacking the container. It would have been obvious to one having ordinary skill in the art in view of *Lafond'807* or *Burton'076* to modify the container of *Kato'127* or *Nakazono'122* so in the region of the back wall includes two parallel lugs to facilitate stacking the container.

Appellant respectfully traverses the rejection.

ii. References Cited in support of the Rejection

Appellant hereby reasserts the descriptions of the references previously presented. The new references cited in the Final Office Action in rejecting Claim 8 are U.S. Patent No. 5,310,076 (*Burton et al.*) and U.S. Patent No. 6,446,807 (*Lafond et al.*).

U.S. Patent No. 5,310,076 (*Burton et al.*)

Burton et al. describe snap-on lid 10 for JEDEC trays 100A-D for surface mount components (SMCs) and other computer chips. See Figure 3. JEDEC trays 100A-D hold surface mount components and lid 10 snap fits over JEDEC tray 100D engaging hold-down tabs 103 thereof. See Figure 4. Snap-on lid 10 includes six hold-down tabs 103. See Figures 3-4.

U.S. Patent No. 6,446,807 (*Lafond et al.*)

Lafond et al. describe an assembly of stacked modular containers 10 for handling, transporting and storing microscope specimen slides 12. A releasable locking arrangement is provided on extension 36, which includes projecting member 38, slit 40 and hole 42. See Figure 1. The under surface of extension 36 also displays projecting member 44 having a shape complementary to the shape of the projecting member 38. See Figure 3. Extension 36 is made flexible to enable manual disengagement of the locking members. See Figure 3.

iii. Arguments Traversing the Rejection of Claim 8

Claim 8 is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made and patentable over U.S. Patent No. 6,179,127 (*Kato et al.*) or U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,076,681 (*Chenoweth*) and U.S. Patent No. 6,293,404 (*Bloom*), further in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

Appellant asserts that Claim 8, dependent upon Claim 1, is patentable for all of the reasons recited *supra* regarding the patentability of Claim 1. See *supra* Part VII(A)(iii).

In addition to these reasons, *Nakazono et al.* disclose structural features for controlling longitudinal sliding movement of modular packaging trays relative to one another. At Col. 2, lines 50-53, *Nakazono et al.* recite:

It is therefore an object of the present invention to provide a packaging tray which can avoid the damages to a display element held therein caused by the displacement of the stacked packaging trays during the transportation.

Nakazono et al. further recite at Col. 6, lines 37-50:

The position determining concave portion 11 is made into a cross in the plan view because the cross composed of four arm portions is the optimal shape when the readiness (work efficiency) in separating the stacked packaging trays 1 and the position fixing properties of the packaging tray 1 are concerned. More specifically, the bottom surface area of the cross position determining concave portion 11 can be reduced as much as possible compared with circular or triangular position determining concave portions 11 of the same size, and the stacked packaging trays 1 can be readily separated. On the other hand, the cross shape composed of four radial arm portions can prevent the displacement of the packaging trays 1, especially in the horizontal direction in a reliable manner. (Emphasis added)

Col. 12, lines 48-57 of *Nakazono et al.* also describes how the “four radial arm portions” effectively prevent the displacement of the packaging trays, “especially in the horizontal position”. Since the structural features of *Nakazono et al.* relative to the resistance of the trays to horizontal or longitudinal movement are already well documented throughout the reference, it is quite unclear why it would be obvious under Section 103 to introduce the projecting members 38 and 44 of *Lafond et al.* for the same purpose again into the trays of *Nakazono et al.*

In essence, the absence of any valid rationale or suggestion for substituting the projecting members of *Lafond et al.* for the horizontal movement controlling “four arm portions” of *Nakazono et al.* already disclosed by *Nakazono et al.* raise the issue that the Primary Examiner’s conclusions are based on impermissible hindsight reconstruction where the substitution becomes apparent after having the benefit of a prior reading of appellant’s own disclosure.

Additionally, *Lafond et al.* fail to disclose “two parallel lugs” as recited in Appellant’s Claim 8. In contrast, *Lafond et al.* describe a transporting tray for microscope specimen slides having substantially different structural features than those of Appellant. While *Lafond et al.* employ projecting members 38 and 44 arranged at different planes designed specifically for preventing longitudinal sliding movement of the trays, projecting members 38 and 44 are not two parallel lugs. See *Lafond et al.*, Figure 3, and Appellant’s Figure 7a. Projecting members 38 and

44 are opposing and laterally displaced. Furthermore, projecting members **38** and **44** engage with the respective projecting members of other containers to slidably lock with one another. Slit **40** allows for member **38** to depress into the locking position. See Figures 3 and 4.

Obviousness cannot be arrived at by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggesting or incentive supporting the combination. *In re Geiger* 2 USPQ2d 1276, 1277 (CAFC 1987). Even if *Lafond et al.* describe “two parallel lugs”, the Primary Examiner is attempting to introduce a single specific structural feature of *Lafond et al.* based solely on the fact that Appellant’s Claim 8 happens to recite this limitation, which the Primary Examiner admits is not taught by *Nakazono et al.*, the primary reference. Before such feature may be introduced into the packaging of *Nakazono et al.*, the Primary Examiner has the burden to show some teaching suggestion or incentive for combining the references, which he has not done. *In re Geiger*.

In regards to *Burton et al.*, tabs **103** and **107** are structurally dissimilar to Appellant’s lugs **63** and are not “two parallel lugs”. Tabs **103** and **107** are adapted for arranging multiple transport containers into a stack. Tabs **103** and **107** of *Burton et al.* are adapted as hold-down tabs for lid **10**. Tabs **103** and **107** of *Burton et al.* are adapted for a snap fitting engagement with detent ridge **28** of lid **10**. Importantly, Appellant’s lugs are not snap-fittings for holding structures together. Appellant’s lugs **63** are adapted to perform a different function from the hold-down tabs of *Burton et al.* This is plainly evident from Figs. 5A and 5B of *Burton et al.*, illustrating tabs **103** and **107** engaging with detent ridge **28** for a snap-fit closure between the JEDEC tray and lid **10**. Additionally, even if tabs **103** and **107** are lugs, *Burton et al.* has not less than twelve hold down tabs **103** and **107** as shown in the figures whereas Appellant’s Claim 8 specifically recites only 2 lugs. Specifically *Burton et al.* recite three tabs **103** and three tabs **107** on each side. See Figure 3.

Neither *Lafond et al.* nor *Burton et al.* offset the deficiencies of *Nakazono et al.* and *Kato et al.* taken with *Chenoweth* and *Bloom* as to make out a *prima facie* case of obviousness under 35 U.S.C. 103(a). It remains unclear to Appellant what motivation there would be to substitute the projecting members of *Lafond et al.* or *Burton et al.* for the system already disclosed by *Nakazono et al.* for preventing horizontal movement of trays, other than impermissible hindsight from a prior reading of Appellant’s own disclosure. Additionally, the structural elements of both *Lafond et al.* and *Burton et al.* are not “two parallel lugs” as recited in Claim 8.

Furthermore, Appellant also wishes to highlight for the record, the fact that the rejection of Claim 8 is based upon a collection of not fewer than **six references**. Such a large collection of art is probative evidence of non-obviousness. While disclosing some of the structural elements of Appellant's claimed container, the need for the Primary Examiner to cite such a thicket of references, and still fail to present a *prima facie* case of obviousness is evidence of the presence of patentable subject matter. The examination process is intended to identify non-patentable subject matter as well as identify allowable claims reciting patentable subject matter. The Primary Examiner has failed to identify the plethora of patentable subject matter in Appellant's claims.

For all of the reasons recited above, including those reasons recited for Claims 1-6 and 9-11 as a whole, Claim 8 is patentable over the combination of *Kato et al.* or *Nakazono et al.* in view of *Chenoweth* and *Bloom* in further view of *Lafond et al.* and *Burton et al.* Claim 8 is patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejection.

D. Ground of Rejection to be Reviewed on Appeal, *supra* Part VI(D)

Whether Claim 12 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

i. Summary of the Rejection

The Primary Examiner in the Final Office Action dated November 9, 2006, finally rejected Claim 12 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

As recited by the Primary Examiner in the Final Office Action:

Claim 12 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazono et al. (6,296,122; hereinafter Nakazono'122) in view of The Official Notice and Anthony et al. (2002/0029989; hereinafter Anthony'989). Nakazono'122 discloses a tray/container (1) comprising a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base (6) is attached to the peripheral delimiting wall, at least one peripheral step (3, Figures 1 and 2) formed in the interior of the tray/container for holding an article (2) spaced away from the base. However, Nakazono'122 fails to show a grip recess being formed in the left and the right sidewall. The Official Notice is taken of the old and conventional practice of providing a container having two grip recesses to facilitate carrying and/or holding the container. Anthony'989, is cited by way of example only, shows a container (10) comprising two grip recesses (28) arranged opposite one another (Figure 1). It would have been obvious to one having ordinary skill in the art in view of The Official Notice and Anthony'989 to modify the container of Nakazono'122 so the left and right sidewall comprises a grip recess to facilitate carrying and/or holding the container.

Appellant respectfully traverses this rejection.

ii. References Cited in support of the Rejection

Appellant hereby reasserts the descriptions of the references previously presented. Both *Nakazono et al.* and *Anthony et al.* have been previously described.

iii. Arguments Traversing the Rejection of Claim 12

Claim 12 is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made and patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*).

The rejection of Claim 12 in the Final Office Action is substantially similar to the rejection of Claim 7. Accordingly, Appellant hereby reasserts the arguments contained in § VII(B) recited *supra*. In summary, Grip notches 29 of *Nakazono et al.* are shown and described as positioned equidistant from the front and back wall. If the grip recesses of the present invention were positioned in the middle portion, they would be rendered unusable. See Appellant's Figures 5 and 6.

The Primary Examiner's Official Notice alleged as a substitute for published prior art is without merit. Appellant's last response contested the conclusion of The Official Notice because this structural feature is not believed to be so well known that prior art need not be cited in support thereof. In response thereof the Final Office Action cites *Anthony et al.* as supplemental published prior art.

However, *Anthony et al.* do not meet the criteria of Claim 12 because *Anthony et al.* fail to teach or suggest a transport container with two grip recesses in the region of the front wall arranged opposite one another. As previously stated, *Anthony et al.* expressly teach recesses 28 are located in the central portion of their tray for gripping purposes. In contrast, Appellant's Claim 12 expressly requires his grips to be formed in the left and right sidewall close to front wall 51 because the mid-portion of sidewalls 53 and 54 of Appellant's transport container can be substantially covered by treatment portion 16. See Figure 6. Additionally, sidewalls 53 and 54 require central openings to accommodate tray clamps 28a. See Figure 5. Consequently, the location of the recesses suggested by *Anthony et al.* in the mid-region of their storage tray will not be suitable for use according to Appellant's claimed invention.

For all of the reasons recited above, especially those recited in § VII(B) of this Appeal Brief, Claim 12 is patentable over *Nakazono et al.* in view of The Official Notice and U.S. Patent Pub. No. 2002/0029989 (*Anthony et al.*). Claim 12 is patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejection.

E. Ground of Rejection to be Reviewed on Appeal, *supra* Part VI(E)

Whether Claim 13 rejected in the Final Office Action dated November 9, 2006, is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made, and therefore, patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

i. Summary of the Rejection

The Primary Examiner in the Final Office Action dated November 9, 2006, finally rejected Claim 13 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*).

As recited by the Primary Examiner in the Final Office Action:

Claim 13 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazono et al. (6,296,122; hereinafter Nakazono'122) in view of Lafond et al. (6,446,807; hereinafter Lafond'807) or Burton et al. (5,310,076; hereinafter Burton'076). Nakazono'122 discloses a tray/container (1) comprising a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base (6) is attached to the peripheral delimiting wall, at least one peripheral step (3, Figures 1 and 2) formed in the interior of the tray/container for holding an article (2) spaced away from the base. However, Nakazono'122 fails to show two parallel lugs being formed at the back wall which serve as guide for arranging the transport container in a stack. Lafond'807 shows a container (12) having two parallel lugs (38, 44) that serve partially as guides for stacking the container. Burton'076 suggests a container (100) having two parallel lugs (103, 107) that serve partially as guides for stacking the container. It would have been obvious to one having ordinary skill in the art in view of Lafond'807 or Burton'076 to modify the container of Nakazono'122 so in the region of the back wall includes two parallel lugs to facilitate stacking the container.

Appellant respectfully traverses this rejection.

ii. References Cited in support of the Rejection

Appellant hereby reasserts the descriptions of the references previously discussed. *Nakazono et al.*, *Lafond et al.* and *Burton et al.* have been previously described.

iii. Arguments Traversing the Rejection of Claim 13

Claim 13 is non-obvious under 35 U.S.C. 103(a) to a person having ordinary skill in the art at the time the invention was made and patentable over U.S. Pat. No. 6,296,122 (*Nakazono et al.*) in view of U.S. Pat. No. 6,446,807 (*Lafond et al.*) or U.S. Pat. No. 5,310,076 (*Burton et al.*).

As previously presented in the arguments traversing the rejection of Claim 8, see § VII(C), *supra*, *Nakazono et al.* disclose structural features for controlling longitudinal sliding movement of modular packaging trays relative to one another. Col. 2, lines 50-53 and Col. 6, lines 37-50.

The absence of any valid rationale or suggestion for substituting the projecting members of *Lafond et al.* for the horizontal movement controlling “four arm portions” of *Nakazono et al.* already disclosed by *Nakazono et al.* raises the issue that the Primary Examiner’s conclusions are based on impermissible hindsight reconstruction where the substitution becomes apparent after having the benefit of a prior reading of appellant’s own disclosure.

As previously presented, *Lafond et al.* and *Burton et al.* fail to describe “two parallel lugs.” However, even if either *Lafond et al.* or *Burton et al.* describe “two parallel lugs”, the rationale for combining *Nakazono et al.* with *Lafond et al.* remains unclear to the Appellant. In effect, the Primary Examiner is attempting to introduce a single specific structural feature of *Lafond et al.* or *Burton et al.* based solely on the fact that Appellant’s Claim 13 happens to recite this limitation, which the Primary Examiner admits is not taught by *Nakazono et al.*, the primary reference. Before such feature may be introduced into the packaging of *Nakazono et al.*, the Primary Examiner has the burden to show some teaching suggestion or incentive for combining the references, which he has not done. *In re Geiger*.

It remains unclear to Appellant what motivation there would be to substitute the projecting members of *Lafond et al.* or *Burton et al.* for the system already disclosed by *Nakazono et al.* for preventing horizontal movement of trays, other than impermissible hindsight from a prior reading of Appellant’s own disclosure. For all of the reasons recited above, especially those in § VII(C), Claim 13 is patentable over U.S. Patent No. 6,296,122 (*Nakazono et al.*) in view of U.S. Patent No. 6,446,807 (*Lafond et al.*) or U.S. Patent No. 5,310,076 (*Burton et al.*). Claim 13 is patentable and Appellant courteously requests that the Appeal Board reverse the Primary Examiner’s rejection.

SUMMARY

As discussed in detail in this Appeal Brief, Claims 1-13 of the pending application under Final Rejection are non-obvious in view of the references cited by the Final Office Action. Claims 1-13 are patentable, Appellant courteously requests that the Appeal Board reverse the Primary Examiner's rejections.

Attached to this Appeal Brief are appendices including a Claims Appendix, an Evidence Appendix, and a Related Proceedings Appendix. Claims 1-13 are listed in the Claims Appendix. Appellant submits no evidence for the Evidence Appendix and there are no related proceedings to be submitted in the Related Proceedings Appendix.

Respectfully submitted,

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Enc.

May 8, 2007

HME/MAR

VIII. CLAIMS APPENDIX

Listing of Claims:

1. A transport container for slides for immunological labeling of thin tissue sections comprising: a left and a right sidewall, a backwall and a frontwall joined together to form a peripheral delimiting wall having interior and exterior sides, a base attached to the peripheral delimiting wall closing off the transport container, at least one peripheral step formed in the interior side of the peripheral delimiting wall, and wherein said base comprises elevations operatively arranged for providing additional support to said slide.
2. The transport container as defined in Claim 1, wherein said at least one peripheral step in said interior side of said peripheral delimiting wall is continuous.
3. The transport container as defined in Claim 2, wherein at least one stop is embodied respectively on the left sidewall and on the right sidewall.
4. The transport container as defined in Claim 1, wherein the transport container is stackable in a stack, such that the base of one transport container constituting in each case the cover for a transport container located beneath it.
5. The transport container as defined in Claim 1, wherein said elevations are comprised of first and second elevations and a planar flattened area located at the same level as the slide.
6. The transport container as defined in Claim 5, wherein the first and second elevations are cup-shaped with a depression closed off by the planar flattened area, depression of the first elevation having a cross section in the form of a circle, and the depression of the second elevation a cross section in the form of a rectangle with rounded edges.
7. The transport container as defined in Claim 1, wherein the delimiting wall of the transport container has embodied on it in the region of the front wall two grip recesses that are arranged opposite one another.

8. The transport container as defined in Claim 1, wherein the delimiting wall of the transport container has shaped on it in the region of the back wall two parallel lugs that serve partially as guides for arranging the transport container in the stack.
9. The transport container as defined in any of Claim 1, wherein the delimiting wall has embodied in the left and the right sidewall at least one protrusion in each case, operatively arranged so the slide does not contact the left or right sidewall in the region of the protrusion.
10. The transport container as defined in Claim 1, wherein the transport container is fabricated from a dimensionally stable material.
11. The transport container as defined in Claim 10, wherein the transport container is injection molded.
12. A transport container for slides for immunological labeling of thin tissue sections, comprising: a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base is attached to the peripheral delimiting wall, wherein the base closes off the transport container, at least one peripheral step formed in the interior of the transport container, wherein the slide rests and is spaced away from the base of the transport container, and a grip recess is formed in the left and the right sidewall close to the front wall.
13. A transport container for slides for immunological labeling of thin tissue sections comprising: a peripheral delimiting wall which is constituted by a left and a right sidewall that are both joined to one another via a back wall and a front wall, a base attached to the peripheral delimiting wall, wherein the base closes off the transport container, at least one peripheral step formed in the interior of the transport container, wherein the slide rests and is spaced away from the base of the transport container, and two parallel lugs formed at the back wall which serve as guide for arranging the transport container in a stack.

IX. EVIDENCE APPENDIX

No evidence is submitted with this Appeal Brief.

X. RELATED PROCEEDINGS APPENDIX

There are no related proceedings.